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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,175	08/11/2005	Herbert Groschup	3249	5446
7590 Striker Striker & Stenby 103 East Neck Road Huntington, NY 17743				
05/29/2009				
EXAMINER				
AHMAD, CHARISSA L				
ART UNIT		PAPER NUMBER		
3635				
MAIL DATE		DELIVERY MODE		
05/29/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/527,175

Applicant(s)

GROSCHUP ET AL.

Examiner

Charissa Ahmad

Art Unit

3635

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 3, 4, 7, 9 and 15-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 6, 8 and 10-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The amendment filed on 12/15/08 is acknowledged. The amendment to the claims is accepted to overcome the objections and the rejection under 35 U.S.C. 112 described in the previous Office Action. Claims 1, 2, 5, 6, 8, and 10-14 will be considered below.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 5, 8 and 10-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Barker (US Patent 3,353,315). [Claim 1] Barker discloses a construction system comprising walls that are configured from panel-type elements (1) wherein the panel-type elements are manufactured from a material containing crushed vegetable-fiber material (Column 2, lines 33-36) and have recesses (2) (Figure 1). [Claim 2] The recesses are formed in the surfaces of the panel-type elements (Figure 1). [Claim 5] The walls are covered on the surfaces containing the recesses by cover panels (30) (Figure 11). [Claim 8] An air gap is located between diametrically opposed, panel-type elements (Figure 11). [Claims 10 and 11] Pillars (13) are manufactured out of wood, fibre board, or metal (Column 2, lines 48-54) (Figure 11). [Claim 12] The walls are composed of pre-manufactured wall elements and are capable of being assembled out of the same. [Claim 13] The wall elements include said panel-type elements (1), pillars (5, 6, 8), a threshold (12) and a top framework (10) (Figure 2). [Claim 14] The

wall elements include cover panels (second panel 1 in the double-walled system of Figure 11) manufactured out of the same material as the panel-type elements.

Claim Rejections - 35 USC § 103

3. **Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barker (US Patent 3,353,315).** Barker discloses the claimed invention, but does not disclose a cover panel that is as thick as the recesses. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the wall of Barker with a cover panel equal in thickness to the thickness of the recesses, since the dimensions would have been a matter of design choice and the wall of Barker would operate equally well with any desired dimensions. No unexpected results are obtained from the claimed dimensional ratios and as such they are viewed as nothing other than obvious choice of design.

Response to Arguments

4. Applicant's arguments filed 3/16/09 have been fully considered but they are not persuasive. In response to applicant's argument that Barker's structural panels are not a construction system for erecting buildings, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, Applicant has failed to provide evidence showing that

Barker's panel is not capable of being used to erect a building. Applicant argues that Barker's panels are only for insulating and space-filling panels. Examiner respectfully disagrees. Barker recites in Column 1, lines 45-53, "Now, therefore, the object of the present invention is to provide light-weight thermal insulating and space filling structural panels for building purposes...in the construction of buildings to provide true surfaces for internal and external surfacing or cladding." Clearly then, Barker's panels are capable of use in erecting buildings.

Secondly, Applicant argues that Barker's panels are not constructed to include recesses adapted for receiving pillars. Again, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, Barker clearly discloses panels with recesses adapted for receiving pillars. In fact, the very title of Barker's invention is "Grooved Panel with Load-Bearing Strips."

Finally, Applicant argues the rejection of Claim 6 under 35 U.S.C. 103(a), in particular that one skilled in the art would not have thought to modify the thickness of the Barker panel elements since Barker recites a cladding on the external surface. In fact, as read, the cladding could also be considered a cover panel to meet the claim limitations. Examiner however has indicated the cover panel as being the second panel 1 in the double-walled system of Figure 11. Clearly, one skilled in the art would have chosen to make the cover panel any desired thickness to achieve the desired

insulative/space-filling properties. The cover panel could be equal in thickness to the recesses (2) of panel 1, or thicker than those recesses without producing an unexpected result. Changing the desired thickness of a cover panel is a matter of obvious design choice.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charissa Ahmad whose telephone number is (571) 270-5220. The examiner can normally be reached on Monday - Friday 7:30 am to 5 pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Charissa Ahmad
Examiner
Art Unit 3635

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/Robert J Canfield/

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